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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,192	10/31/2001	Humio Inaba	0020-4893P	9467

2292 7590 05/28/2003

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EXAMINER

PAIK, STEVE S

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/914,192

Applicant(s)

INABA ET AL.

Examiner

Steven S. Paik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on February 25, 1999. It is noted, however, that applicant has not filed a certified copy of the JP11/47995 application as required by 35 U.S.C. 119(b). This National State application should include the copy of the certified copy of the abovementioned priority document. Such copy is respectfully requested as a response to this Office Action.

### ***Response to Amendment***

2. Receipt is acknowledged of the Amendment filed October 31, 2002.

### ***Claim Objections***

3. Claim 8 is objected to because of the following informalities: the word "signa," in line 4 on page 28 appears to be -- signal --. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase, "at least one inking material of a kind capable of", in line 8 of an independent claims 1, 6 and 8 do not definitely describe the claimed information carrier medium responding to a coherent light when irradiated thereby. In a situation where the claimed method is not capable of responding to a coherent light, the applicant has no other inking material to

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further claim the invention. Accordingly, the examiner respectfully amending or replacing the phrase with -- at least one inking material for -- or -- at least one inking material --.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Soules et al. (US 5,522,623).

Re claims 1-4, Soules et al. (hereinafter Soules) disclose an information carrier medium (10 in Fig. 1 or 20 in Fig. 2) comprising:

at least first and second sheet members (upper lamina 11 or 21 and lower lamina 12 or 22. Also there is disclosed an intermediate coded layer between the upper and lower laminae.) each having first and second surfaces opposite to each other (top and rear faces), said first and second sheet members (upper lamina 11 or 21 and lower lamina 12 or 22) being laminated together (Abstract and see col. 5, lines 65, 66 and col. 6, lines 13) with the first surface of the first sheet member bonded to the first surface of the second sheet member (the top face of the second member is supporting the intermediate coded layer); and

a security indicium (a barcode 13, a finger print 16, a barcode 23, or a barcode 26) formed on at least one of the first faces of the respective first and second sheet members, said security indicium being made of at least one inking material for responding to a coherent light (col. 9, Table I discloses various combinations of sources, appropriate detectors and the optical

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response) when irradiated thereby. It is well known in the art that coherent light includes a nitrogen laser, a xenon laser, an argon ion laser, and ionized neon laser. Soules teaches an IR or UV laser beam as one of various light sources in column 9, lines 5-39. A barcode reading procedure includes differentiating the amount of light absorbed and reflected from the code printed by an inking material when irradiated by a light source (col. 6, lines 43-56). Hence, the inking material used to print the barcode or fingerprint in Soules is also considered to absorb the coherent light, emit light, and scatter light when irradiated by the coherent light (col. 11, ll. 36-42) with a predetermined wavelength.

Re claims 5 and 9-11, Soules discloses the information carrier medium (10 in Fig. 1, 20 in Fig. 2 or 30 in Fig. 3) recited as rejected claim 1 stated above, where the security indicium (a barcode 13, a finger print 16, a barcode 23, or a barcode 26) formed on such one of the first surfaces of the respective first and second sheet members (upper lamina 11 or 21 and lower lamina 12 or 22. Also there is disclosed an intermediate coded layer between the upper and lower laminae, and the top face of the second member is supporting the intermediate coded layer.) is visible to naked eyes (col. 6, lines 41-43 teaches the code may or may not be visible to the human eye).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soules et al. (US 5,522,623) in view of Sano et al. (US 5,971,276, equivalent to the applicant cited European Patent Application).

Re claims 6 and 8, the teachings of Soules have been discussed above. Soules discloses an information carrier medium and a reading system of the medium.

Although Soules discloses a reading device (electro-optical reading means in col. 6, ll. 43-56), he does not specifically disclose each of the claimed elements of the reading means.

Sano reference teaches a method and apparatus for reading a code pattern including a light source (11) to illuminate a portion (2) of the information medium (1) in register with the security indicium; and a photo detector means (12 in Fig. 1) for detecting rays of light obtained from that portion of the information carrier medium; and a detecting means (an image analyzer 54, i.e. computer and a monitor 53) connected to the photo-detector (see Fig. 6) for comparing output from the photo-detector with a reference signal stored therein to verify an authenticity of the information carrier medium.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further combine a pattern or code reading device including a light source, a photo-detector, and an analyzer, as taught by Sano with the information carrier medium of Soules due to the fact that more selective and precise detection of wavelengths and transmission of the detected wavelengths can be achieved through a filter and a photo-detector. As a result of such modification of employing a pattern/code reader to the information carrier medium of Soules, more precise and secure reading of the pattern would be achieved.

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10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Soules et al. (US 5,522,623) as modified by Sano et al. (US 5,971,276) as applied to claim 6 above, and further in view of Modlin et al. (US 6,097,025).

The teachings of Soules et al. in view of Sano et al. have been discussed above. Soules et al. in view of Sano et al. discloses all the claimed feature of the invention with the exception of a first and a second photo-detectors.

Modlin et al. discloses a barcode reader comprising, among other things, a detector selection device including a first light-transmission pathway for directing light transmitted from a composition at the examination site toward a first detector the detector selection device is set in a first position, and a second light-transmission pathway for directing light from the composition toward a second detector when the detector selection device is set in a second position, so that different detectors can be used for different applications by actuating the detector selection device between the first and second positions.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the photo detector of Sano et al. with the photo detector of Modlin et al. for the purpose of selecting an appropriate photo detector in accordance a detected light-transmission pathway to increase applicability of the reading device. Such modification would have been an obvious matter of design variation to broaden the usage of the reading device, well within the ordinary skill in the art, and therefore an obvious expedient.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Bianco (US 4,359,633) disclose an identification card having a base with a region, which absorbs invisible light and a region which reflects invisible light. Both regions absorb visible light over a predetermined spectral range.

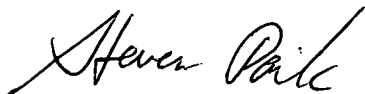
Rudland (US 4,538,059) discloses an identification card with a code that is readable by an optoelectronic reader but is invisible in ordinary light.

Beck et al. (US 4,044,231) discloses a secure document and method of making the secure document. Beck further discloses an optical/magnetic reader comprising a light source and a detector.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 703-308-6190. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6893 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0530.



Steven S. Paik  
Examiner  
Art Unit 2876

ssp  
May 5, 2003